

**REMARKS**

The Office Action of January 19, 2006 has been received and reviewed. This response is directed to that Action.

Claim 1 has been amended to include the ratios of component (1) to component (2). Support for this amendment can be found in the specification on page 28, lines 23-24; page 29, line 16; page 30, lines 18-19; page 31, line 10; page 33, line 7; and page 34, line 34.

Claims 5 and 6 have been cancelled.

Claim 7 has been amended to maintain consistency in the claims due to the amendments and cancellations listed herein.

Reconsideration in view of the foregoing amendments and following arguments is respectfully requested.

**Claim Rejections- 35 U.S.C. §103**

The Examiner rejected claims 1-17 under 35 U.S.C. §103(a) as obvious over Horodysky (US 4,389,322) or Horodysky et al. (US 4,478,732) or Horodysky et al. (US 4,594,171) (collectively the "Horodysky references") or Doner et al. (US 5,068,045) in view of Karol et al. (US 6,806,241). The Examiner stated that the Horodysky references and Doner disclose an organo borate ester composition in the form of borated derivatives of ethoxylated amides which are effective friction reducing additives for lubricating oils. The Examiner also stated that Karol et al. teaches all of the additives of component (2) of the present invention. The Examiner

Application No. 10/678,408

concluded that it would have been obvious to a person of ordinary skill in the art to combine the references to arrive at the claimed invention.

With respect to Karol et al. (US 6,806,241), applicants respectfully submit that the Examiner has improperly cited this reference against the present invention because Karol et al. is prior art under 35 U.S.C. §102(e), and Karol et al. and the present invention are owned by, and subject to an obligation of assignment, to the same person. Specifically, 35 U.S.C. §103(c)(1) states, in pertinent part,

“Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person”.

Therefore, because the citation of Karol et al. under 35 U.S.C. §103 over the present claims is improper, the applicants submit that the *prima facie* case of obviousness cannot be established, and respectfully request that the Examiner withdraw this rejection.

In the event that the Examiner is able to cite alternative prior art references similar to Karol et al. that teach the additives of component (2), applicants respectfully request that the finality of the rejection be withdrawn.

Notwithstanding, applicants have amended the claims to further define the present invention. Claim 1 has been amended to include the ratio of component (1) to component

(2). As such, applicants now claim an invention that does not simply arbitrarily combine an organo borate ester with any of the additives of component (2), but rather combines these components in a manner which maximizes the synergistic properties of the combination

Applicants further submit that the present invention exhibits unexpected results when components (1) and (2) are combined according claim 1. This is clearly displayed in the extensive test data set forth in the specification. On page 27, first paragraph, it is explained that while high concentrations of borate ester may provide adequate antiwear protection, lower amounts of borate ester alone lead to significantly inferior antiwear performance (Table A; Table 1, compare tests 1 and 10). Yet it has now been discovered that contrary to what would be expected from these tests, such low amounts of borate ester can nevertheless be used when combined with the additives of component (2) to provide the synergistic composition.

It is also demonstrated that the additives of component (2) alone do not provide sufficient protection. Page 28, lines 14-24 and Table 2 and Figure 2 show that the additive Vanlube 871 thiadiazole compound alone, or when combined in a very low level ratio of borate ester, does not provide adequate antiwear protection. However, when the borate ester is combined with the thiadiazole additive in a ratio of 1:3 or higher, excellent results are achieved. Similarly surprising results are seen for bisdithiocarbamates (page 29, lines 11-18; Table 4), dithiocarbamates (page 30, last paragraph; Table 3) and for all of the other claimed additives.

Application No. 10/678,408

In view of the amendments above and the foregoing, applicant submits that the Examiner would be fully justified to reconsider and to withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is, therefore, earnestly solicited.

Applicant also believes that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.


**CONDITIONAL PETITION FOR EXTENSION OF TIME**

If entry and consideration of the amendments above requires an extension of time, Applicant respectfully requests that this be considered a petition therefor. The Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

**ADDITIONAL FEE**

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

Respectfully submitted,  
NORRIS McLAUGHLIN & MARCUS, P.A.

By   
Mark D. Marin  
Reg. No. 50,842  
875 Third Avenue  
18<sup>th</sup> Floor  
New York, New York 10022  
Phone: (212) 808-0700  
Fax: (212) 808-0844